

### REMARKS

Claims 17-33 were withdrawn from consideration as being directed to nonelected embodiments identified in the restriction requirement dated July 18, 2005. Claims 17-33 have now been canceled. Applicants reserve the opportunity to present such claims or claims of a different or broader scope in a divisional or continuation application. New claims 41-42, which depend from claim 1, have been added. Written description support for claims 41-42 are found throughout the original specification, for example, at page 8, line 26 through page 10, line 19; at FIGS. 1A-1C and 6A-9. No new matter has been by these amendments. Accordingly, claims 1-16 and 33-42 are pending.

#### Claims 1-16 and 41-42

The Office Action indicated that independent claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dixon (U.S. Patent No. 6,432,461), in view of Golchert (U.S. Patent No. 4,024,287) and Waters (U.S. Patent No. 6,376,000). The Office Action also indicated that some dependent claims were unpatentable over Dixon, Golchert, and Waters in further view of Russell (U.S. Patent No. 6,623,553).<sup>1</sup> Even if there was a suggestion in the prior art to combine these references, such a combination does not disclose all the elements of the independent claim 1, as required by MPEP § 2143.03.

Unlike independent claim 1, Dixon, Golchert, Waters, and Russell—alone or in combination—fail to describe applying onto a carrier an image that is “disproportionate relative to an original version of the image” and fail to describe an forming a three dimensional impression in the carrier “such that the three dimensional impression formed in the carrier corresponds to a three dimensional representation of the original version of the image.”

Instead, Dixon teaches that either (1) an “artist paints/airbrushes/colours by hand to simulate the final finished appearance of the decoration” or (2) an “artist scans into the computer

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<sup>1</sup> It is believed that the Office Action considers Dixon, Waters, and Russell to be prior art under 35 U.S.C. § 102(e). That Applicants distinguish the Dixon, Waters, and Russell references herein from Applicants' claimed subject matter should not be taken as an admission that Applicants have conceded that any of the Dixon, Waters, and Russell references is properly considered prior art under any sub-section of 35 U.S.C. § 102.

the original single dimensional artwork,” which is used to directly make “printing screens for the silk screen printing process.” (*See* Dixon at col. 5, lines 24-50.) Golchert describes that a user may trace or copy an original image onto a substantially flat sheet (transfer medium 22), and then that image is transferred to a substantially flat surface such as a cake top. (*See* Golchert at col. 2, lines 16-65.) Waters describes that an original image printed onto a substantially flat edible paper is transferred to another substantially flat surface in a chocolate molding process. (*See* Waters at col. 4, lines 10-65; FIGS. 2-3 and 6.) Russell describes various edible ink formulations that may be employed in a “lithographic printing apparatus or process” to transfer the ink to “a food article or a transfer sheet.” (*See* Russell at col. 4, line 65 to col. 5, line 65.)

Accordingly, even if there was a suggestion in the prior art to combine Dixon, Golchert, Waters, and Russell as proposed by the Office, such a combination would not disclose all of the elements of independent claim 1, as required by MPEP § 2143.03. Applicants respectfully submit that independent claim 1 and dependent claims 2-16 and 41-42 are patentable over the cited references of record and are in condition for allowance.

#### Claims 34-40

The Office Action indicated that independent claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dixon, in view of Golchert and Waters. The Office Action also indicated that some dependent claims were unpatentable over Dixon, Golchert, and Waters in further view of Russell. Again, even if there was a suggestion in the prior art to combine these references, such a combination does not disclose all the elements of the independent claim 34.

Unlike claim 34, Dixon, Golchert, Waters, and Russell—alone or in combination—do not describe “measuring misalignment of the deformed outline to the three-dimensional impression and creating an adjusted two-dimensional artwork based on the original two-dimensional artwork and the measurements.” One having skill in the art would have appreciated the inventive method set forth in independent claim 34 only upon access to Applicants’ specification, which is impermissible in the context of a §103 analysis.

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Accordingly, even if there was a suggestion in the prior art to combine Dixon, Golchert, Waters, and Russell as proposed by the Office, such a combination would not disclose all of the elements of independent claim 34, as required by MPEP § 2143.03. Applicants respectfully submit that independent claim 34 and dependent claims 35-40 are patentable over the cited references of record and are in condition for allowance.

No fee is believed to be due at this time. If necessary, please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Michael T. Hawkins  
Reg. No. 57867

Fish & Richardson P.C., P.A.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696